



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2021-0005]

Administrative Updates to the General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) previously published a notice requesting comments on the implementation of certain administrative updates to the General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office (GRB). The USPTO has considered the comments and, based on the support for the proposals, is implementing the updates to the GRB. There are three categories of technical and scientific qualifications that may typically make applicants eligible to sit for the registration examination: Category A for specified bachelor's degrees, Category B for other bachelor's degrees with technical and scientific training, and Category C for practical engineering or scientific experience, which may be demonstrated by passing the Fundamentals of Engineering test. Based on the USPTO's evaluation and comments received, the USPTO is changing the criteria to: add common Category B degrees to Category A, accept advanced degrees (i.e., master's and doctor of philosophy degrees) under Category A, and accept a combination of core sciences under

Category B, Options 2 and 4, so long as one of the core science courses has a lab component.

DATES: The revised GRB incorporating the proposed updates will be published and applicable as of [INSERT DATE OF PUBLICATION IN THE FEDERAL REGISTER].

FOR FURTHER INFORMATION CONTACT: Will Covey, Director of the Office of Enrollment and Discipline, by telephone at 571-272-4097 or by email at oed@uspto.gov.

SUPPLEMENTARY INFORMATION:

Summary

On March 23, 2021, the Office published a request for comments on three proposals to change the criteria for sitting for the registration examination: (1) adding common Category B degrees to Category A, (2) accepting advanced degrees (i.e., master's and doctor of philosophy degrees) under Category A, and (3) accepting a combination of core sciences under Category B, Options 2 and 4, so long as one of the core science courses has a lab component. The Office received 32 comments in response to this request for comments as of May 24, 2021 (the closing date for comments). An overwhelming majority of the comments were supportive of the suggested changes.

This notice provides information relating to the implementation of the three proposals.

Background

The Director of the USPTO is given statutory authority to require a showing by patent practitioners that they possess “the necessary qualifications to render applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.” 35 U.S.C. § 2(b)(2)(D). The courts have

determined that the USPTO Director bears the primary responsibility for protecting the public from unqualified practitioners.

Pursuant to that responsibility, USPTO regulations provide that registration to practice in patent matters before the USPTO requires a practitioner to, *inter alia*, demonstrate possession of scientific and technical qualifications.¹ The role of patent practitioners with scientific and technical backgrounds in providing full and clear patent specifications and claims has long been acknowledged. The USPTO publishes the GRB, which sets forth guidance for establishing possession of scientific and technical qualifications. The GRB is available at www.uspto.gov/sites/default/files/documents/OED_GRB.pdf.

The GRB lists three categories of scientific and technical qualifications that typically make one eligible for admission to the registration examination: (1) Category A for specified bachelor's degrees, (2) Category B for other bachelor's degrees with technical and scientific training, and (3) Category C for individuals who rely on practical engineering or scientific experience by demonstrating that they have passed the Fundamentals of Engineering test. If a candidate for registration does not qualify under any of the categories listed in the GRB, the USPTO will conduct an independent review for compliance with the scientific and technical qualifications pursuant to 37 CFR 11.7(a)(2)(ii).

The USPTO has evaluated, and continues to evaluate, the list of typically qualifying training set forth in the GRB. These evaluations seek to clarify guidance on what will satisfy the scientific and technical qualifications and to identify possible areas of

¹ Legal representation before Federal agencies is generally governed by the provisions of 5 U.S.C. § 500. That statute, however, provides a specific exception for representation in patent matters before the USPTO. 5 U.S.C. 500(e). *See* 35 U.S.C. 2(b)(2)(D) [formerly 35 U.S.C. 31].

improved administrative efficiency. To that end, the USPTO published a notice requesting comments on three proposed updates to the GRB: (1) adding common Category B degrees to Category A, (2) accepting advanced degrees (i.e., master's and doctor of philosophy degrees) under Category A, and (3) accepting a combination of core sciences under Category B, Options 2 and 4, so long as one of the core science courses has a lab component. *See "Request for Comments on Administrative Updates to the General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office,"* 86 FR 15467 (March 23, 2021).

The USPTO received 32 comments from intellectual property organizations, universities, industry, a law firm, individual patent practitioners, and the general public. The USPTO acknowledges and appreciates the many comments that were submitted from the intellectual property community. The comments are available at:

www.regulations.gov/document/PTO-P-2021-0005-0001/comment. The USPTO has considered the comments, including those that raised concerns or provided suggestions. The USPTO is implementing the proposals as stated in the request for comments, and as explained below. Additional suggestions beyond the scope of the request for comments and the questions posed therein were provided in many of the comments. The USPTO appreciates the suggestions and may address them in the future, once further evaluation and data are garnered.

This notice merely describes agency policy and procedures and does not involve substantive rulemaking. While the criteria for admission to practice in patent matters is generally described in 37 CFR 11.7, the rule does not set forth the specific scientific and technical criteria for admission.

Administrative Update 1: Add Common Category B Degrees to Category A

As explained further in the GRB, bachelor's degrees listed under Category A present prima facie evidence of the requisite technical and scientific qualifications. Prior to this notice, the bachelor's degree under Category A may only have been in one of the following subjects: biology, biochemistry, botany, computer science, electronics technology, food technology, general chemistry, marine technology, microbiology, molecular biology, organic chemistry, pharmacology, physics, textile technology, aeronautical engineering, agricultural engineering, biomedical engineering, ceramic engineering, chemical engineering, civil engineering, computer engineering, electrical engineering, electrochemical engineering, engineering physics, general engineering, geological engineering, industrial engineering, mechanical engineering, metallurgical engineering, mining engineering, nuclear engineering, and petroleum engineering. These degree categories will remain listed under Category A.

Acceptable computer science degrees under Category A must be accredited by the Computer Science Accreditation Commission of the Computing Sciences Accreditation Board or by the Computing Accreditation Commission of the Accreditation Board for Engineering and Technology on or before the date the degree was awarded. This requirement for computer science degrees under Category A remains unchanged by this notice. Based on the comments received, the USPTO will continue to evaluate this requirement in light of the type of computer science degrees (i.e., whether accredited or not) and the nature of computer science degrees generally awarded by colleges and universities.

Starting in early 2020, the USPTO undertook a review of Category B applications to identify bachelor's degrees that are routinely accepted as demonstrating the requisite scientific and technical qualifications. This review is ongoing. Based on the analysis to date and comments received, and understanding that Category A cannot be an exhaustive

list of all degrees that would qualify, the Office is expanding the above list of Category A degrees to expressly include the following degrees that are routinely accepted under Category B: aerospace engineering, bioengineering, biological science, biophysics, electronics engineering, genetic engineering, genetics, marine engineering, materials engineering, materials science, neuroscience, ocean engineering, and textile engineering. Listing these Category B degrees under Category A will improve operating efficiency and streamline the application process for prospective patent practitioners.

The USPTO also invited comments on any additional degrees that should be considered under Category A. Based on the comments received and a review of the applicants in the suggested degree categories over the past three calendar years (i.e., 2018 through 2020), the USPTO is also expanding the list of Category A degrees to expressly include the following degree: environmental engineering. Other degree categories suggested by commenters were considered but are not being included under Category A at this time to allow for the additional collection and evaluation of data on these degree categories. For example, one of the degree categories suggested by commenters was artificial intelligence. In the past three calendar years, however, there have been no applicants with an artificial intelligence degree. The USPTO will continue to monitor degree categories as the degrees and data develop.

The Office will continue to accept degrees where the transcript demonstrates equivalence to a Category A degree (For example, molecular cell biology may be equivalent to biology, and materials science and engineering may be equivalent to materials science.).²

² See OED Frequently Asked Questions (FAQs), available at www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/oed-frequently-asked-questions-faqs.

Administrative Update 2: Accept Advanced Degrees Under Category A

Prior to this notice, Category A did not include post-baccalaureate degrees. Based on a review of applicants and the comments received, the USPTO is updating the GRB to list possession of a master's or a doctor of philosophy degree in a Category A subject as demonstrating acceptable technical and scientific training. This includes the newly added Category A degrees listed above and degrees where the transcript demonstrates equivalence to a Category A degree.

Administrative Update 3: Accept a Combination of Core Sciences Under Category B, Options 2 and 4

Prior to this notice, Category B, Option 4 in the GRB required a combination of 40 credit hours in acceptable technical and scientific courses, including at least 8 hours in either chemistry with a lab or 8 hours in physics with a lab. Category B, Option 2, which focuses on training in biology and related sciences, had a similar requirement. The requirement for lab-based core science courses is meant to ensure familiarity with the processes involved in conducting valid experiments, the scientific method, and proper analysis of scientific data.

It is not clear whether multiple courses in either chemistry or physics alone, with a lab, provide an appreciable benefit over general core science training. Accordingly, the USPTO is revising Category B, Option 4 by changing "8 semester hours in chemistry or 8 semester hours of physics ... obtained in two sequential courses, each containing a lab" to "eight semester hours in a combination of chemistry, physics, and/or biology, with at least one course including a lab." Category B, Option 2, which already requires training

in biology, is being revised to require at least “eight semester hours in a combination of chemistry and physics, with at least one course including a lab.”

Andrew Hirshfeld,

Commissioner for Patents,

Performing the Functions and Duties of the Under Secretary of Commerce for

Intellectual Property and Director of the United States Patent and Trademark Office.

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